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OFFICE OF PETITIONS

In re Application of
Johansson et al.
Application No. 10/079,807
Filed: February 22, 2002
Attorney Docket No. 7582.0005-02

: DECISION ACCORDING
: STATUS UNDER
: 37 CFR 1.47(a);
: DECISION GRANTING REQUEST
: FOR CORRECTED FILING RECEIPT

This decision concerns the September 12, 2002 "Petition under 37 CFR 1.47(a)"; and the June 4, 2002 "Request for Corrected Filing Receipt," which is being treated as a petition under 37 CFR 1.182.

The petition under 37 CFR 1.47(a) is **GRANTED**.
The petition under 37 CFR 1.182 is **GRANTED**.

Petition under 37 CFR 1.47(a)

Three inventors are named in this application: Bernth Johansson ("Johansson"), Alan J. Witten ("Witten") and Anthony J. Devaney ("Devaney"). The application upon filing did not include an oath or declaration as required by 37 CFR 1.51(b)(2) and as specified in 37 CFR 1.63. A Notice to File Missing Parts of Nonprovisional Application was mailed on April 12, 2002, giving Applicants an extendable 2-month period to submit, *inter alia*, a proper oath or declaration.¹ In response, the instant petition was filed, accompanied by a "Declaration and Power of Attorney" signed only by Witten and Devaney but not Johansson ("9/12/02 Declaration"). The petition requests that the 2 signing inventors be allowed to file this application on behalf of themselves and Johansson, for the reason that Johansson refuses to join in this application.

Under 37 CFR 1.47(a), Witten and Devaney may file this application on behalf of themselves as well as Johansson provided that a *bona fide* attempt has been made to present to Johansson, for signature, a copy of the entire application (specification including the claims; drawings), and that the latter refuses to join in this application.²

To show that Johansson has refused to join in this application despite such a *bona fide* attempt, the petition must include, *inter alia*, a statement of facts concerning the circumstances of the presentation of the application papers to Johansson at his last known address,³ and his subsequent

¹ The other missing items were subsequently filed along with requests for extensions of time and the extension-of-time fees.

² See *infra* note 4.

³ 37 CFR 1.47(a); MPEP section 409.03(e) (Aug. 2001).

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refusal.⁴

The petition contains essentially a statement of facts by counsel for Assignee, Kenneth M. Lesch ("Lesch") ("Lesch Statement"). The Lesch Statement in conjunction with the accompanying exhibits sets forth that:

- Lesch mailed a copy of the application to Johansson at his last known work address on 4 occasions: May 8, 2001; September 4, 2001; January 8, 2002; and again May 23, 2002;
- Johansson replied by facsimile on January 14, 2002 that he would not sign the papers, but did not responded since the May 23, 2002 mailing.

In view of the above, the Office concludes that Lesch had made a *bona fide* attempt to present to Johansson, for review and signature, a copy of the entire application (specification including the claims; **drawings**) before concluding that Johansson refused to join in this application. The §1.47(a) petition is thus granted.⁵ The 9/12/02 Declaration is hereby accepted. The application is now complete.

The Office acknowledges receipt with the petition of the \$130 petition fee and the \$130 surcharge for lacking an acceptable oath/declaration upon filing of the application.

As provided in 37 CFR 1.47(c), the Office will forward notice of the filing of this application to Johansson at his last known work address provided in the petition, where Johansson appears to have no problem receiving his mail:

Bernth Johansson
Head of Research & Development
Malå Geoscience
Skolgatan 11
S-930 70 Malå
Sweden

Notice of the filing of this application will also be published in the *Official Gazette*.

⁴ See MPEP section 409.03(d) (Aug. 2001) (Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted . . . When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts.).

⁵ The petition is granted based on the assumption that copies of the drawings were sent to Johansson along with the applications on 5/8/01, 9/4/01, 1/8/02, 5/23/02. If this is not true, counsel must inform this Office upon receipt of this decision.

Petition under 37 CFR 1.182

This application is a continuation of application no. 09/866,575, which in turn is a continuation of application no. 09/658,188, which claims benefit of provisional application no. 60/152,607, filed on September 8, 1999. However, the Filing Receipt mailed on April 12, 2002 mis-states the filing date for the provisional application as being September 9, 1999.

The June 4, 2002 request is thus granted, in that, the April 12, 2002 Filing Receipt is hereby withdrawn. No fee is owed.

The application file is being returned to the Office of Initial Patent Examination for further processing with respect to the 9/12/02 Declaration, and for mailing of a corrected filing receipt reflecting the correct filing date for provisional application no. 60/152,607. Thereafter, the application will be forwarded to Technology Center 3600 for examination in due course.

Telephone inquiries should be directed to the undersigned at (703) 308-0763.



RC Tang
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Office of the Commissioner
for Patents

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